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EXAMINER THAKUR, VIREN A				
ART UNIT		PAPER NUMBER		
1794				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/524,279

**Applicant(s)**

SAR-EL ET AL.

**Examiner**

VIREN THAKUR

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 10-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of claims 1-9 in the reply filed on October 3, 2008 is acknowledged. The traversal is on the ground(s) that each of groups II-VI do not each comprise inventions separate and distinct from each other or otherwise separate and distinct from Group I. This is not found persuasive because the groups lack corresponding technical features, as disclosed in the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 1 recites the limitation "winding (wrapping)," it is noted that these terms do not connote the same process and therefore the claim is not clear as to what step applicant is attempting to claim. In light of this, the claim does not appear to positively recite wrapping a sector of the product designated to be marked. That is, the claim merely recites a marking tag that comprises a band

that is capable of wrapping a sector of the product designated to be marked. It is further noted that claims 2-9 interchangeably recite winding or wrapping. In light of the rejection of claim 1, as discussed above, claims 2-9 are also not clear as to whether applicants intend to wrap or to wind the band around the product.

Claim 1 further recites "band (also known as 'cable tie')." The limitation in the parenthesis does not positively recite that the band is a cable tie but rather only recites that the broad limitation "band" can also be called a cable tie. Furthermore, the specification does not provide a specific definition for what is a cable tie or a band. Therefore, the limitation is not clear as to the relationship between the band and the cable tie. Claims 5 and 6 provide similar indefinite recitations of "(cable tie)."

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claim 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Wenk (US 2183799).**

Regarding claim 1, and in light of the rejection under 35 U.S.C. 112, second paragraph, above, it is noted that Wenk discloses a marking tag that

comprises a band that is wound around at least a sector of the product to be marked (figure 1). It is further noted that cable ties have also been conventionally made from metal components and therefore, it is further considered that the cable disclosed by Wenk is a cable tie. Regarding claim 2, Wenk discloses marking kosher attributes (page 2, left column, lines 25-27). Regarding claim 3, Wenk discloses marking poultry (page 1, left column, line 2) and as shown in 1, has marked a chunk of meat. Regarding claim 5, it is noted that Wenk inherently discloses piercing an opening in the product for threading the band through the opening. As can be seen in figure 1, clearly, the band has been threaded through the meat product and therefore, the meat has been pierced to make an opening through which the band is threaded.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wenk (US 2183799) in view of Swett (US 3021630), Morgam Holdings (FR2192732) and Diamond et al. (BE839165).**

Claim 4 differs from Wenk in specifically reciting wherein the method is implemented in a production line and comprises a conveyor upon which the food products are handled, and wherein the winding of the marking tags is accomplished without arresting the operation of neither said production line nor the conveyor.

It is noted that Swett teaches a production line with a conveyor for continuously marking poultry (column 2, lines 34-38). It is noted that this is considered without arresting the operation since Swett teaches that the poultry has been marked as it passes by the marking machine. In addition, Morgam Holdings teaches high speed production of meats wherein the process further results in the high speed marking of the poultry, and therefore provides further motivation for the automatic production of marking food products. As can be seen by figure 3, the tag surrounds the product as opposed to being embedded within the product. In addition, Diamond et al. provides further evidence of an automatic marking system for meat products. To therefore modify Wenk and employ an automatic production process would therefore have been obvious to one having ordinary skill in the art, for the purpose of increasing the efficiency by

which the meat products are marked with the particular tag. Also, it is not seen that one can predicate patentability on making a batch process continuous.

**9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 4 and in further view of Wescombe (US 6226911).**

Regarding the particular piercing step, if one were to construe that Wenk did not explicitly disclose a piercing step, it is noted that Wescombe has been relied on to teach a method wherein the meat product (column 1, lines 7-8) is first pierced and after which, a marking tag has been threaded through the opening (see column 1, lines 26-34; column 2, lines 4-10). For instance, the method further comprises wherein the opening through which the tag is inserted is maintained open so that the tag can be inserted there-through (column 5, lines 38). Wescombe also teaches that this process can be a mechanical process (column 5, line 18). To therefore modify Wenk and employ a mechanical piercing and tagging process, as taught by Wescombe would have been obvious for the purpose of ensuring that the tag has been cleanly inserted through the opening made in the meat product.

**10. Claim 6 is rejected under 35 U.S.C 103(a) as being unpatentable over the references as applied to claim 4, above, and in further view of Ruell (US 4171766).**

Claim 6 differs from the combination in specifically reciting wherein the marking tag comprises adding a hologram onto the band.

Ruell teaches the concept of applying a hologram onto a card, which is impossible to separate the identification card from the hologram without visible destruction of one or the other (column 2, lines 3-8). Nevertheless, Ruell thus also teaches that it was conventional in the art to weld holograms onto a substrate for the purpose of providing added authenticity of the matter printed on the marking tag (column 1, lines 56-66). Since Wenk teaches that a printed copy (17) for marking and identification purposes has been provided on one side of the marking tag, to further modify the marking tag, and employ a hologram, which is impossible to remove without destroying the tag or the hologram, would have been obvious to one having ordinary skill in the art for its art recognized and applicants' intended function.

**11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 6, above, and in further view of Tinklenberg et al. (US 6058639), Spencer et al. (US 4770729), Hollander (US 4227614) and in further view of Fukami (US 5799375).**

Regarding the particular process, it is noted that Ruell teaches employing a hologram to a label, as discussed above with respect to claim 6. To therefore modify the combination and apply a hologram to the marking tag, would have been obvious for the purpose of providing an improved authenticity to the label applied to the meat product, as discussed above with respect to claim 6.



Claim 7 differs from the previously applied combination in specifically reciting that the band is wound around the product and then the hologram is fed into position between a welding tip and the band for securing the hologram to the band.

Tinklenberg et al. teaches that it was conventional in the art to first wrap food products with a band and then apply a marking tag to the wrapped band (figure 5). To therefore first wrap the product with a band and then apply the marking tag to the band would have been an obvious matter of choice and/or design, since Tinklenberg et al. teaches that this was a conventional expedient for securing a tag to a band that has already been wound around a product.

Claim 7 differs from the combination in specifically reciting the particular positioning, coupling and attaching the anvil means to the surface of the product and winding the band around both the product and the anvil. It is noted that the claim does not recite how the anvil is coupled or attached to the product. It is noted that applicants disclose that by anvil means, applicants are referring to a support structure for the purpose of ultrasonic welding a hologram label to the band (See paragraph 0037 of applicants Pre-Grant Publication).

Regarding the particular positioning of the anvil, it is noted that Spencer et al. teaches affixing a label to a wire or band (see figure 3, item 13A, item 45 and item 47). The label tag has been affixed to the band (item 35) using ultrasonic welding wherein the anvil and welder sandwich the band. Therefore, the art teaches that this has been a conventional positioning of the anvil for the purpose of employing ultrasonic welding for securing a label to a band. Spencer further

teaches that the welding apparatus can be used to weld a tag onto not only elongate wires but also continuous wires, such as rings (column 12, lines 29-31). Spencer also teaches that the welding can be done with a hand-held type device as well (Column 12, lines 55-59).

Additionally, Hollander has been relied on to teach that ultrasonic welding is a known technique wherein a weld is made by employing an anvil "behind" the product to be welded (column 3, lines 1-14). Clearly, and similar to applicants, the anvil provides a support surface for the welding. To therefore place an anvil behind the band onto which the hologram or other marking is to be affixed, would have been obvious to one having ordinary skill in the art, since the positioning of the anvil behind the object to be welded has been a conventional method for ultrasonically welding objects.

Tinklenberg et al. teaches a non-welding, but conventional technique for securing a tag to the band. Nevertheless, since Spencer teaches that ultrasonic welding has been a conventional expedient for securing a label to a band and since Hollander teaches that it has been conventional in the art of ultrasonic welding to place the product to be welded between the welding tip and an anvil opposite the welding tip, to substitute one conventional method for securing the marking tag onto the band, for another conventional securing method, such as ultrasonic welding would have been obvious to one having ordinary skill in the art, for the purpose of providing a more secure attachment of the label to the band. Nevertheless, in order to employ ultrasonic welding, it would further have been obvious to the ordinarily skilled artisan to have placed an anvil between the

band and the product, since this anvil provides the support required to weld the marking tag to the band.

Regarding the particular movement of the welding means and anvil, it is noted the particular movement (i.e. retreating the welding means and extracting the anvil) would have been obvious steps for the purpose of applying a particular marking tag to the product. For instance, it would have been obvious that the particular welding means would have needed to be moved into position for applying a hologram to the label. Furthermore, the retreating of the welding means and the extracting of the anvil would also have been obvious for the purpose of advancement of the meat product once the meat product was marked. Therefore these steps would not have provided a patentable distinction over the prior art taken as a whole, which already teaches an automated marking system that can employ a particular type of label, such as a hologram.

Regarding the limitation of winding the band around the product and the anvil, it is noted that whether the ordinarily skilled artisan first wrapped the band and then secured the anvil between the band and the product, or whether the ordinarily skilled artisan first placed the anvil against the product and then wrapped the band around the anvil and the product would have been an obvious matter of choice and/or design, since the only purpose of the anvil is to support welding. In either case it would have been advantageous to be able to remove the anvil after welding the marking onto the band and as a result, the particular order of placing the anvil against the product would have been routinely

determinable for the purpose of ensuring that the anvil is secure for facilitating welding and for removing the anvil after welding.

Regarding winding the band around the product and the anvil, it is further noted that on paragraph 0085 of the Pre-Grant Publication, applicant discloses that the device for applying the band has been conventional equipment for this purpose. In light of this, Fukami has also been relied on as further evidence of devices that can wind a band around an object (see figure 2). To therefore employ conventional devices for the purpose of winding a band around or through an object would therefore have been obvious to one having ordinary skill in the art.

Regarding the automatic device for winding bands, it is noted that Malosse teaches the mechanical securement of a tag which winds around the meat product. Nevertheless, the art already teaches the step of winding using mechanical apparatuses and therefore the particular automated device would not have provided a patentable distinction over the prior art, taken as a whole. Additionally, it is noted that the claim does not positively recite an engagement step. The claim only positively recites the step of "advancing said automatic device for wrapping bands to a position in which it will," or is capable of engaging the product while the anvil means is attached to the product. Therefore, by advancing conventional devices for winding bands around a product, as discussed above, these devices would have been capable of the engagement of the product while the anvil is attached to the product.

Regarding claim 8, which recites the particular positioning of the anvil and the winding device, it is noted that claim 7, from which claim 8 depends, does not recite that the winding of the band and the welding of the hologram occurs simultaneously. As such, the particular orientation of the winding device and the location of the anvil would have been an obvious matter of choice and/or design depending on the particular arrangement of the winding and welding devices in the process. For instance, using a conventional winding device, such as that taught by Fukami, it would have been obvious to have placed the anvil opposite to this device, since placing the anvil on the same side as the device would have gotten in the way of the device providing a tight winding of the band on the object.

**12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 7-8 and in further view of Wescombe (US 6226911) and Merle (US 1657865).**

Regarding claim 9, which recites piercing the product intended to be marked and winding the band through the aperture, it is noted that Wenk already teaches piercing the product and winding the band through the aperture.

Wescombe has been relied on as discussed above with respect to claim 5, for the purpose of teaching that it was conventional to employ a machine which provides the opening in the meat, for marking with a tag, and then threading a band through the opening. Merle has been relied on as further evidence that it was conventional in the art to first pierce the product and then

thread through a marking tag (page 2, left column, lines 27-29). To therefore employ a conventional piercing process, would therefore have been obvious for its art recognized and applicants' intended function.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 3628230 discloses an apparatus for piercing a ring through an object, thus teaching that it was conventional in the art to provide an apparatus that pierces and dispenses a band through an object. US 5311688 discloses wrapping a band around an object and then securing a marking tag onto the band. US 3491470 discloses using sonic welding to permanently seal the marking tag to the band. US 2669047 discloses securing a band to an object and then securing a marking tag onto the band (figure 5). US 5595220 discloses a band winding device. US 6845577 discloses a marking tag applied after winding a band around an object. US 4246712 discloses that various types of connections can be used to secure the marking tag to the bands (column 5, lines 26-28).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIREN THAKUR whose telephone number is (571)272-6694. The examiner can normally be reached on Monday through Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571)-272-1540. The

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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